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REMARKS

In the Official Action mailed December 3, 2001, claims 1-16 and 21-23 were rejected. By this response, claims 3-5, 16, and 22 have been amended. Upon entry of the amendments, claims 1-23 will remain pending in the present application. Reconsideration of the rejection and allowance of the pending claims are respectfully requested.

Rejection Under 35 U.S.C. § 112

In the Official Action, claims 3-4, 16, and 22 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that:

The term "fluidicly" in claims 3-4, 16 and 22, is vague and indefinite, while the accepted term is "fluidly or fluidally."

In addition, the Examiner stated that:

Claim 16 recites the limitation "a motor protector" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claims 3-5, 16, and 22 have been amended to replace the term "fluidicly" with the term "fluidly" in light of the Examiner's first comment. In addition, claim 16 also has been amended in light of the Examiner's second comment. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102(b)

In the Official Action, claims 1, 2, 6, 14, 15, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rabson, U.S. Patent No. 4,815,949. However, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir.

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1990). To maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Claims 1, 2, 6 are not anticipated by the Rabson reference because the cited reference does not teach every element of claims 1, 2, and 6. Claims 2 and 6 depend from independent claim 1. Independent claim 1 recites the following:

1. An electric motor, comprising:

a plurality of stator sections, each stator section including an outer housing, wherein the plurality of stator sections are mechanically and electrically coupleable to form a stator of a desired length; and

a rotor, disposed within the plurality of stator sections.

One of the recited features of claim 1 that is not shown by the Rabson reference is "a rotor disposed within the plurality of stator sections." The electric motor of the Rabson reference is a reciprocating electric motor, i.e., a linear electric motor. *See Rabson*, Abstract and col. 4, lines 3-5. The reciprocating electric motor of Rabson has an armature or mover 83, not a rotor. *See Rabson*, col.2, line 67-col. 3, line 2. The armature 83 of the Rabson reference does not rotate. Rather, the field winding 91 of the Rabson reference causes the armature 83 to reciprocate in an up-and-down manner to drive a pump piston. *See Rabson*, col. 3, lines 45-68. Thus, the armature 83 is not "a rotor disposed within the plurality of stator sections," as recited in claim 1.

Other recited features of claim 1 that are not shown by the Rabson reference are "a plurality of stator sections, *each stator section including an outer housing*, wherein the plurality of stator sections are mechanically and electrically coupleable to form a stator of a desired length." In the Rabson reference, a plurality of coils 92 are stacked coaxially within a motor housing 77 on a support tube 113. *See Rabson*, col. 4, lines 5-7. The coils 92 are stacked in

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groups, each group constituting one motor stator module or unit. *See Rabson*, col. 4, lines 8-11. However, all of the coils 92 are housed within a single motor housing 77. Therefore, only a single stator section is shown in the Rabson reference because all of the coils 92 are housed in a single outer housing 77. Therefore, the motor 75 of the Rabson reference does not show "a plurality of stator sections."

Furthermore, the Rabson reference does not show "a plurality of stator sections, wherein the plurality of stator sections are *mechanically coupleable*." The Rabson reference does not show that either the individual coils 92 or the motor stator modules are mechanically coupleable to other individual coils 92 or motor stator modules. Therefore, the Rabson reference does not show "a plurality of stator sections, each stator section including an outer housing, wherein the plurality of stator sections are mechanically coupleable," as recited in claim 1. Finally, neither the individual coils 92, nor the motor stator modules or units, are mechanically and electrically coupleable to form a stator *of a desired length*. The length of the single outer housing 77, not the individual coils 92 or the motor stator modules or units, defines the length of the field winding 91 of the Rabson reference. For all of these reasons, independent claim 1 and dependent claims 2 and 6 are not anticipated by the Rabson reference.

Additionally, claims 14 and 15 also are not anticipated by the Rabson reference. Claim 15 depends from independent claim 14. Independent claim 14 recites the following:

14. A submersible pumping system, comprising:

a submersible electric motor, including:

a plurality of modular motor sections, each motor section includes a stator section and a housing section, wherein the modular motor sections are mechanically and electrically coupleable to form a motor of a desired length;

a rotor disposed within the plurality of modular motor sections;
and

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a submersible pump, drivingly coupled to the rotor of the submersible electric motor.

Similarly to the analysis with respect to claim 1, one of the recited features of claim 14 that is not shown by the Rabson reference is "a rotor disposed within the plurality of modular motor sections." As discussed above, the motor 75 of the Rabson reference is a linear electric motor, not a rotary electric motor. Thus, the motor 75 of the Rabson reference has an armature 83, not a rotor. Furthermore, the Rabson reference does not teach a plurality of modular motor sections. The only housing section shown in the Rabson reference is the single outer housing 77. Therefore, the Rabson reference only shows a single stator section because only a single outer housing is shown by the cited reference. The Rabson reference simply does not show a plurality of modular motor sections wherein *each* modular motor section includes a stator section *and* a housing section. Furthermore, the stacked component stator of Rabson is not a modular motor section. Although the coils of Rabson may be stacked, the field winding 91 of the Rabson reference does not show modular motor sections. Electrical connectors 163 and 165 of Rabson require connectors 167 in order to interconnect the groups of coils. *See Rabson*, col. 5, lines 21-30. In order to create sets of coils for the linear motor of Rabson, connectors 167 are necessary to connect each coil in each group of one set to a corresponding coil in another group of that same set. Thus, connectors 167 must be run from connectors 163 and 165 of one coil out to the outer edge of the coil, along the outside of a group of coils, to the outer edge of another coil in another group of that set and, finally, to connectors 163 and 165. *See Rabson*, Fig. 5. This connection process must be completed coil-by-coil as the individual coils are stacked, not just as each group of coils is stacked. The motor 75 of the Rabson reference simply does not have a rotor disposed within a plurality of modular motor sections.

Some other recited features of claim 14 that are not shown by the Rabson reference are "a plurality of modular motor sections, each motor section includes a stator section and a housing section, wherein the modular motor sections are mechanically and electrically coupleable to form a motor of a desired length." First, as discussed above, the motor 75 of the Rabson reference does not teach a plurality of modular motor sections, wherein each motor section includes a

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housing section. Second, the Rabson reference does not show "a plurality of modular motor sections, wherein the plurality of modular motor sections are *mechanically coupleable*." The Rabson reference does not show that either the individual coils 92 or the motor stator modules are mechanically coupleable to other individual coils 92 or motor stator modules. Therefore, the Rabson reference does not show "a plurality of modular motor sections, wherein the modular motor sections are mechanically and electrically coupleable," as recited in claim 14. Finally, neither the individual coils 92, nor the motor stator modules or units, are mechanically and electrically coupleable to form a motor *of a desired length*. The length of the single outer housing 77, not the individual coils 92 or the motor stator modules or units, defines the length of the field winding 91 of the Rabson reference. For all of these reasons, independent claim 14 and dependent claim 15 are not anticipated by the Rabson reference.

Independent claim 21 also is not anticipated by the Rabson reference. Independent claim 21 recites the following:

21. An electric motor for a submergible pumping system, comprising:

a plurality of stator sections adapted to form a stator of a desired length, wherein each of the plurality of stator sections comprises a mechanical and electrical coupling to permit selective attachment to an adjacent stator section ; and

a rotor disposed within the plurality of stator sections.

One of the recited features of claim 21 that is not shown by the Rabson reference is a rotor. As discussed above, the motor 75 of the Rabson reference is a linear electric motor, not a rotary electric motor. Thus, the motor 75 of the Rabson reference has an armature 83, not a rotor. The motor 75 of the Rabson reference simply does not have a rotor.

Furthermore, the Rabson reference does not teach "a plurality of stator sections adapted to form a stator of a desired length, wherein each of the plurality of stator sections comprises a

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mechanical and electrical coupling to permit selective attachment to an adjacent stator section.” The Rabson reference does not show that either the individual coils 92 or the motor stator modules has a mechanical coupling to permit selective attachment to an adjacent coil 92 or motor stator module. Therefore, the Rabson reference does not anticipate claim 21.

For all of these reasons, the Rabson reference does not anticipate claims 1, 2, 6, 14, 15, and 21. Withdrawal of the rejection and allowance of claims 1, 2, 6, 14, 15, and 21 are respectfully requested.

First Rejection Under 35 U.S.C. § 103

Claims 3-5, 16, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rabson in view of Schob, U.S. Patent No. 5,939,813. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Claims 3-5, 16, and 22 are patentable because the cited references do not show all of the recited features of the claims. Claims 3-5 depend from independent claim 1, claim 16 depends from independent claim 14, and claim 22 depends from independent claim 21. As discussed above, the Rabson reference does not disclose all of the recited features of claims 1, 14, and 21.

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Therefore, the Rabson reference does not disclose all of the recited features of claims 3-5, 16, and 22. The Schob reference does not obviate the deficiencies of the Rabson reference, because it does not disclose, teach or suggest, the various elements missing from the Rabson reference. Therefore, claims 3-5, 16, and 22 are patentable over the cited references. Withdrawal of the rejection and allowance of claims 3-5, 16, and 22 are respectfully requested.

Second Rejection Under 35 U.S.C. § 103

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rabson in view of Ekstromer, U.S. Patent No. 2,098,958. Claim 13 is patentable because the cited references do not show all of the recited features of the claims. Claim 13 depends from independent claim 1. As discussed above, the Rabson reference does not disclose all of the recited features of claim 1. Therefore, the Rabson reference does not disclose all of the recited features of claim 13. The Ekstromer reference does not obviate the deficiencies of the Rabson reference, because it does not disclose, teach or suggest, the various elements missing from the Rabson reference. Therefore, claim 13 is patentable over the cited references. Withdrawal of the rejection and allowance of claim 13 is respectfully requested.

Third Rejection Under 35 U.S.C. § 103

Claims 7-12 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rabson in view of Ekstromer, U.S. Patent No. 1,960,484. Claims 7-12 and 23 are patentable because the cited references do not show all of the recited features of the claims. Claims 7-12 depend from independent claim 1. In addition, claim 23 depends from independent claim 21. As discussed above, the Rabson reference does not disclose all of the recited features of independent claims 1 and 21. Therefore, the Rabson reference does not disclose all of the recited features of claims 7-12 and 23. The Ekstromer reference does not obviate the deficiencies of the Rabson reference, because it does not disclose, teach or suggest, the various elements missing from the Rabson reference. Therefore, claims 7-12 and 23 are patentable over the cited references. Withdrawal of the rejection and allowance of claims 7-12 and 23 are respectfully requested.

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Attachment

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

General Authorization for Extensions of Time

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, Applicants authorize the Commissioner to charge the appropriate fee for any extension of time to Deposit Account No. 06-1315; Order No. REDA:0093/VAN (89.0425).

Conclusion

In view of the above remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Date: March 1, 2002



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend claims 3-5, 16, and 22 as follows:

3. (Amended) The electric motor as recited in claim 1, wherein at least some of the plurality of stator sections are ~~fluidiely~~ fluidly coupleable to allow a fluid flow therethrough.

4. (Amended) The electric motor as recited in claim 2, wherein the first stator section and the second stator section are ~~fluidiely~~ fluidly coupleable to allow fluid to pass between the first and the second stator sections.

5. (Amended) The electric motor as recited in claim 2, wherein the second stator section is ~~fluidiely~~ fluidly coupleable to an external device.

16. (Amended) The system as recited in claim 15, further comprising a motor protector, wherein the first, second and third stator sections are ~~fluidiely~~ fluidly coupleable so as to allow fluid to pass between the first stator section and a the motor protector.

22. (Amended) The electric motor as recited in claim 21, wherein each of the plurality of stator sections is ~~fluidiely~~ fluidly coupleable to an adjacent stator section.